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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,670	01/18/2005	Hideji Tajima	10287.65	2325
27683 7590 11/26/2008 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER				
POPA, ILEANA				
ART UNIT		PAPER NUMBER		
1633				
MAIL DATE		DELIVERY MODE		
11/26/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/501,670

**Applicant(s)**

TAJIMA, HIDEJI

**Examiner**

ILEANA POPA

**Art Unit**

1633

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,2 and 4-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: see continuation sheet.

/Ileana Popa/  
Examiner, Art Unit 1633

Continuation of 13:

Claims 1, 2, and 4-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Safir et al. (U.S. Patent No. 6,491,823, of record), in view of each Tajima et al. (U.S. Patent No. 5,702,950), Ikeda et al. (U.S. patent No. 6,607,662), and Deschamps et al. (Protein Expression and Purification, 1995, 6: 555-568).

It is noted that most of Applicant arguments were previously presented and answered in the final Office action of 08/07/2008. In addition, Applicant argues that none of the cited references teach a drawing/discharging section configured to draw a fluid through the inlet/outlet into the carrier housing section and then discharge the fluid out of the carrier housing section through said inlet/outlet. Applicant argues that Safir et al. only teach that the drawing/discharge section draws fluid through an injection valve and into a column, however, the drawing/discharge section does not discharge the fluid out of the column, as required by claim 1. In response to this argument, it is noted that the valve with its inlets and outlets is considered part of the carrier housing section and therefore, Safir et al. do teach drawing a fluid through the inlet/outlet into the carrier housing section and then discharging the fluid out of the carrier housing section through the same inlet/outlet.

Claims 1, 2, 4, 5, 8, 12-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima (U.S. Patent No. 5,895,631).

Applicant argues that the proposed modification of Tajima renders Tajima unsatisfactory for its intended purpose. Applicant argues that discloses a reaction liquid containing magnetic particles with bound DNA, which are separated by the remainder of the reaction liquid by drawing the reaction liquid (including the magnetic particles) into a cylindrical chip via a nozzle, contacting the cylindrical chip with a magnetic body to attract the magnetic particles within the chip on an internal surface of the chip, and discharging the residual liquid through the nozzle. Applicant argues that the proposed modification (i.e., such that the magnetic particles are not able to pass through the inlet-outlet) would render Tajima unsatisfactory for its intended purpose because the magnetic particles would no longer be able to be drawn up through the inlet-outlet into the cylindrical chip, and thus, the magnetic particles would not be able to be separated from the remainder of the reaction liquid.

Applicant's arguments are acknowledged however, they are not found persuasive for the following reasons:

The intended purpose in Tajima is to separate the magnetic particles from the rest of the reaction fluid. The suggested modification proposes that the particles are already within the cylindrical chip and they have a size such that they are not able to pass through the inlet-outlet outside of the cylindrical chip and into the remaining of the reaction fluid. Since the particles are already inside the chip, there is no need to draw them through the inlet-outlet. Such a modification would readily separate the magnetic particles from the remainder of the reaction fluid; furthermore, such a modification would avoid loss of magnetic beads (and therefore, loss of captured material). Therefore, such a modification improves Tajima et al.

For the reasons above, Applicant's arguments are not found persuasive and the rejections are maintained.